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Paper No. 29

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DWIGHT A. MERRIMAN and KEVIN O'CONNOR

Appeal No. 2004-1828
Application No. 09/094,949¹

ON BRIEF

Before GROSS, SAADAT and MACDONALD, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 85-100. Claims 1-84 have been canceled.

We reverse.

BACKGROUND

Appellants' invention is directed to automated selection of direct advertisements that correlate with particular users and groups of users of media. According to Appellants, when Internet users make a transaction or click on a direct advertisement, such

¹ Application for patent filed June 15, 1998, which claims the filing priority benefit under 35 U.S.C. § 119 of Provisional Applications No. 60/048,940, filed June 16, 1997 and No. 60/049,877, filed June 17, 1997.

as an advertisement banner, their browsers are redirected to an advertiser's server to respond to the user's request (specification, page 25). The advertiser's server responds by transmitting the requested information as well as some additional relevant information to be displayed by the user's browser (specification, pages 25 & 26). An understanding of the invention can be derived from a reading of exemplary independent claim 85, which is reproduced as follows:

85. A method for advertisement selection, comprising:

(a) receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements;

(b) receiving a request to display a direct advertisement to a user; and

(c) selecting, in response to the request, one of the plurality of direct advertisements for display based at least in part upon the advertiser feedback.

The Examiner relies on the following references:

Frank V. Cespedes et al. (Cespedes), "Database Marketing: New Rules for Policy and Practice," Sloan Management Reviews, Summer 1993, pp. 7-22.

Youji Kohda et al. (Kohda), "Ubiquitous advertising on the WWW: Merging advertisement on the browser," Computer Networks and ISDN Systems, Vol. 28, 1996, pp. 1493-1499.

Bill Harvey (Harvey), "The Expanded ARF Model: Bridge to the Accountable Advertising Future," Journal of Advertising Research, March/April 1997, pp. 11-20.

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"Microsoft Press Computer Dictionary" (Microsoft Dictionary), Third edition, 1997, p. 387.

Claims 85-88, 90-93, 95-98 and 100 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohda and Cespedes.

Claims 89, 94 and 99 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohda and Cespedes and further in view of Microsoft Dictionary.

Claims 85-88, 90-93, 95-98 and 100 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohda and Harvey.

Claims 89, 94 and 99 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohda and Harvey and further in view of Microsoft Dictionary.

We make reference to the answer (Paper No. 25, mailed October 24, 2003) for the Examiner's reasoning and to the appeal brief (Paper No. 24, filed June 27, 2003) and to the reply brief (Paper No. 26, filed December 24, 2003) for Appellants' arguments thereagainst.

OPINION

We initially note that in rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Furthermore, in considering the question of the obviousness of the claimed

invention in view of the prior art relied upon, the Examiner is expected to make the factual determination set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The Examiner must not only identify the elements in the prior art, but also show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Such evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984).

Appellants argue that Kohda obtains information for selecting advertisements from users by negotiating with users, who agree to see specific categories of advertisements while browsing (brief, page 5). Appellants further point out that in Kohda, the advertisements are chosen based on information obtained from the filters stored on the user's augmented Web browser and according to the user's specified categories of

advertisement (brief, page 6). To further distinguish the claims over Kohda, Appellants contest the Examiner's characterization of the user's clicking the links as the claimed receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site (brief, page 6; reply brief, page 2).

In response to Appellants' arguments, the Examiner concedes that selecting the advertisement based on the advertiser feedback is indeed missing in Kohda (answer, page 10), and argues that Harvey or Cespedes provide the missing feature (answer, page 11). However, the Examiner's rebuttal requiring Appellants to explain why Kohda's selection of advertisements could not be based at least in part upon advertiser feedback is misplaced. Rather than addressing how the database marketing of Cespedes or Harvey would have suggested selecting advertisements based at least in part upon advertiser feedback, the Examiner asserts that:

If the advertisers are aware and can tailor their advertisement, there is no apparent reason why the system and method could not be modified to utilize information already obtained by the system/method as set forth under the 103 rejections.
(Answer, page 19)

It is the Examiner, and not Appellants, who has the initial burden of establishing a prima facie case of obviousness.

Cespedes, specifically in the portions relied on by the Examiner (answer, pages 5 & 6), relates to targeting product

marketing to specific users' needs based on a database of users' credit card purchase information. Although the database marketing of Cespedes selects the advertisements presented to a user based on the available user information in the database, it is not clear exactly what features of Cespedes teach or suggest the selection of advertisements based at least in part upon advertiser feedback. Similarly, the Examiner relies on the high level discussion of advertisement models in Harvey to conclude that adding the specific claimed language regarding the advertiser feedback to Kohda is suggested by Harvey. However, we remain unconvinced that any of these advertisement approaches conclusively establishes the obviousness of modifying Kohda to include the claimed selection of advertisements based at least in part upon advertiser feedback, as recited in claim 85.

Additionally, Appellants argue that the advertisement Kohda selects for display is not from the same plurality of advertisements to which the user responded (brief, page 7; replay brief, page 4). However, we do not find any specific arguments presented by the Examiner to address this limitation or to rebut Appellants' position. As argued by Appellants, there is nothing in Kohda to indicate that the selected advertisements based on the information received from the augmented browser are from the advertisements that led to the user's transaction.

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We note that claims 90, 95 and 100 include similar limitations related to the selection of advertisements based at least in part upon advertiser feedback which, as discussed above with respect to claim 85, are absent in the prior art. Accordingly, since the Examiner has failed to meet the burden of providing a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of claims 85-88, 90-93, 95-98 and 100 over Kohda and Cespedes or Harvey cannot be sustained.

With respect to the rejection of the remaining claims, the Examiner further relies on Microsoft Dictionary for using a direct proxy server. However, Microsoft Dictionary does not overcome the deficiencies of Kohda, Cespedes and Harvey, alone or in combination, as discussed above with respect to claim 85. Therefore, we do not sustain the 35 U.S.C. § 103 rejection of claims 89, 94 and 99 over Kohda, Cespedes and Microsoft Dictionary or over Kohda, Harvey and Microsoft Dictionary.

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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 85-100 under 35 U.S.C. § 103 is reversed.

REVERSED

Anita Pellman Gross

ANITA PELLMAN GROSS
Administrative Patent Judge

Maxwell D. Gradat

MAHSHID D. SAADAT
Administrative Patent Judge

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AND
INTERFERENCES

Alfred MacDonell

ALLEN R. MACDONALD
Administrative Patent Judge

MDS/ki

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KENYON & KENYON
One Broadway
New York, NY 10004